

REMARKS

[0001] Claims 1-24 are pending in the case. Claim 2 has been cancelled. Claims 18-20 have been withdrawn. Claims 23 and 24 have been renumbered to fix a typographical error. Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3154162 to McCaleb *et al.* (hereinafter “McCaleb”) in view of U.S. Patent No. 6009363 to Beckert *et al.* (hereinafter “Beckert”). Claims 1, 3-17, 21 and 22 are allowed.

[0002] Claim 1 has been amended to correct the typographical error at line 5 as suggested by the Examiner.

RESPONSE TO REJECTION OF CLAIMS 1-3 UNDER 35 U.S.C. §103(a)

[0003] Independent Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McCaleb in view of Beckert. It is unclear according to the Office Action which reference is being used to reject Claims 23 and 24. First, the Office Action states that the claims are being rejected in view of Manak. However, the Office Action proceeds to discuss Beckert. Because Beckert is listed in a previous list of references used by the Examiner, Applicant will assume Beckert is used to reject Claims 23 and 24 under 35 U.S.C. § 103(a).

[0004] It is well known that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on

applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See* MPEP § 2142 under the heading "ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS."

[0005] Applicant respectfully asserts that neither McCaleb or Beckert teaches or suggests all of the claim limitations. Specifically, Beckert does not teach "a smartcard reader to receive a smartcard from a user, the smartcard enabling usage-based billing." *See* Claim 23.

[0006] Beckert teaches a vehicle computer system that can support applications pertaining to entertainment, navigation, communications, security, diagnostics, and others. *See* col. 2, lines 16-17. The vehicle computer system includes multiple peripheral devices including CD-ROM, AM/FM Tuner, audio signal processor, navigation system, security sensors, vehicle diagnostics, and to devices to facilitate the data communication between the peripheral devices. *See* col. 2 lines 61-64. The computer system taught by Beckert also includes multiple input options including a keypad, PCMCIA card slots, IrDA, CD, USB, Firewire, joystick, TV tuner, and a smart card reader.

[0007] The smart card reader of Beckert functions as a storage device or allows the user to download programs from a storage medium. *See* col. 2 lines 21-24. Beckert further teaches that "the computer module 64 also has a smart card interface 140 which accepts smart cards." *See* col. 7, lines 42-43. Smart cards are not discussed further by Beckert.

[0008] Conversely, the present invention teaches a smart card that can carry the user's authority and can enable usage based billing directly. The smart cards may be used in a manner similar to calling cards where money is paid at first for a predefined amount of usage. *See* paragraph 0063. The specification reasonably conveys that the usage includes numerous activities including, but not limited to, enabling vehicle movement and functioning as an

activating key to make the REV functional.

[0009] Beckert does not teach a system that can enable or disable the movement of a vehicle, therefore Beckert likewise does not teach or enable a smart card that enables usage based billing. The Office Action has not cited a teaching or suggestion for each and every element. Nothing in the prior art teaches how to combine the references to come up with the claimed invention. That is, even if the combination is suggested, nowhere does it teach how to make the combination such that a smart card enables or disables vehicle functionality. The Office Action makes this connection only through impermissible hindsight.

“To reach a proper determination under 35 U.S.C. 103, **the examiner must step backward in time** and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner **must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination**, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. **However, impermissible hindsight must be avoided** and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” (emphasis added) (See MPEP §2142).

[0010] Therefore, in determining motivation to combine, it is impermissible to use the specification or disclosure provided by the Applicant as a “road map” to guide one from the teachings in McCaleb to the teachings in Beckert. Here, the Office Action clearly utilizes the claimed invention as a “road map” to guide one from McCaleb to Beckert because neither McCaleb nor Beckert suggest, expressly or impliedly, the combination as asserted by the Office Action.

[0011] In view of the issues raised above, Applicant respectfully asserts that Claim 23 is patentable over the cited references, and respectfully request that the rejection under 35 U.S.C. §

103(a) be withdrawn. Additionally, Applicant respectfully submits that Claim 24 is allowable for depending from an allowable independent claim.

[0012] In view of the foregoing, Applicant submits that the application is in condition for immediate allowance. In the event any questions remain, the Examiner is respectfully requested to initiate a telephone conference with the undersigned.

Respectfully submitted,

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